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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/590,139	02/11/2008	Neil Duggal	HO-P03203US0	5647				
44270 IMDS, INC. 124 SOUTH 600 WEST LOGAN, UT 84321	7590 03/16/2010		<table border="1"><tr><td>EXAMINER</td></tr><tr><td>SNOW, BRUCE EDWARD</td></tr></table>		EXAMINER	SNOW, BRUCE EDWARD		
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			<table border="1"><tr><td>NOTIFICATION DATE</td><td>DELIVERY MODE</td></tr><tr><td>03/16/2010</td><td>ELECTRONIC</td></tr></table>	NOTIFICATION DATE	DELIVERY MODE	03/16/2010	ELECTRONIC	
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03/16/2010	ELECTRONIC							

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

khansen@imds.net

### Office Action Summary

**Application No.**

10/590,139

**Applicant(s)**

DUGGAL ET AL.

**Examiner**

Bruce E. Snow

**Art Unit**

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 32-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: 12/4/08, 10/24/07, 8/22/06

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of species 11 (Figures 25-31) in the reply filed on 2/4/10 is acknowledged.

Claim 40 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species shown in figure 36. It is noted that the "resilient body" limitation in combination with the elected species would be consider new matter, not enabling, and is not shown.

### ***Priority***

Applicants "certified copy of the foreign priority application" fails to shown the elected embodiment of figures 25-31. Please clarify. All claims have been interpreted as having filing date of 2/11/08.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 32-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding all claims, where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written

description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "flat" or "flattened" is used by the claim to mean "straight", a single dimensional description, while the accepted meaning is a two dimensional description. The term is indefinite because the specification does not clearly redefine the term. The Examiner notes that the scope of the claims get very confusing in claim 58 wherein a planar portion is termed "flat" and a cylindrical portion is termed "flat".

Claims 41-50 are not understood. What is the orientation feature and what is the scope?

Regarding claim 51, how can the "flattened section" be flat in more than one cross section?

Regarding claim 58, how can the third articular surface comprise more than one cross section which is flat?

Regarding claim 56, what is the stop member?

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: orientation feature (claim 41), stop member (claim 56).

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the hole in the flange (claim 57) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory obviousness-type double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 32-63 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over all claims of copending Application No. 11/559,215. Although the conflicting claims are not identical, they are not patentably distinct from each other. Applicant is has elected to prosecute the same species in both case. The same species contains the same limitations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***As far as the scope of the claims can be determined, the following prior art is made of record.***

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

### ***Claim Rejections - 35 USC § 103***

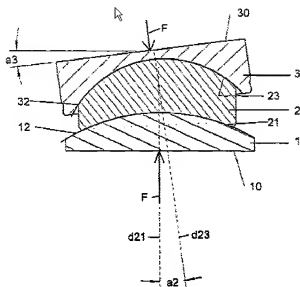
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32-39, 41, 42, 44, 46-50 are rejected under 35 U.S.C. 102(a, b, e) as anticipated Beaurain et al (2004/0243240).

Beaurain et al teaches an intervertebral disc prosthesis comprising

fig. 8c



a first end plate 1 and a second end plate 3 which can comprise bone engagement features such as 8 or 81 as shown in figures 6a and 13.

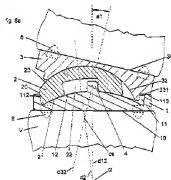
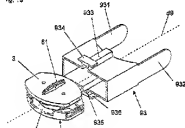


fig. 13



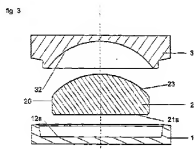
The prosthesis further comprising a nucleus 2 which articulates between said first and second plates which urges the plates into a relative anterior/posterior angle that provides a lordotic angle as shown in figure 8c.

Regarding at least claim 42, having a flattened section, Beaurain et al teaches many embodiments having a flattened section such as figure 3, articulating surfaces



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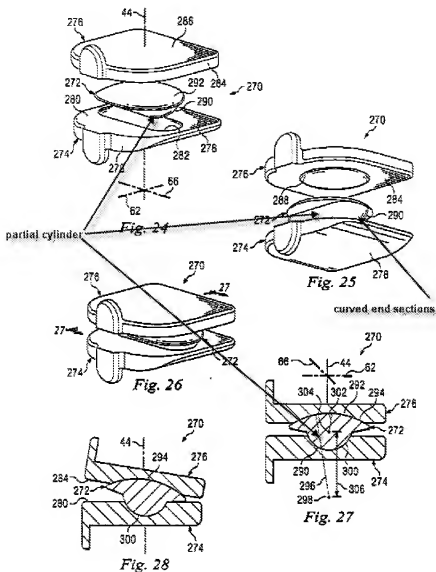
21a and 12a (first and second orientation features). Canted relative upper and lower plates are not required for this claim.



Claim 43, the flatten section is contiguous with the upper curved articulating surface.

Claims 32-39, 41-62 are rejected under 35 U.S.C. 102(a, b, e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Marik et al (2005/0216086).

Marik et al teaches an intervertebral disc prosthesis comprising



a first end plate 274 and a second end plate 276 which can comprise bone engagement features such as a flange (stop). The prosthesis further comprising a nucleus 272 which articulates between said first and second plates which urges the plates into a relative anterior/posterior orientation that provides a preferred lordotic angle including 0.

Regarding claims 33, 39, 54, 60 a cross section at the posterior can be taken closer to the posterior end when compared to a cross section at the anterior end taken further from anterior end; the chosen anterior portion would have a greater thickness than the chosen posterior portion. The device is interpreted as having a preferred lordotic angle greater than zero.

Regarding at least claims 43, Marik et al teaches a partial cylinder (as shown) which comprises a flattened portion in one cross section flanked by first and second curved ends which inherently have a different radii.

Claim 52, see surface 284 which comprises a concave recess and a flat portion. Also see paragraph 0066 which states, "the interior surface may include a concave recess 288" which is interpreted as being optional.

Claims 57 and 62, under 35 U.S.C. 103(a), it would have been obvious to one having ordinary skill in the art to put a hole in the flange for a screw with predictable results. This is well known in the art.

Claim 58, fourth surface 288 is interpreted as being substantially flat.

Claim 59, see reasoning for claim 52.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bruce E Snow/  
Primary Examiner, Art Unit 3738